

REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed April 1, 2008, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed non-provisional and provisional applications set forth in the concurrently filed amendment.

The petition is DISMISSED

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;**
- (2) the surcharge set forth in 5 1.17(t); and**
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.**

The petition does not comply with item (1).

This pending nonprovisional application was filed on April 10, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/195,491, which was filed on April 10, 2000, and for which priority is claimed. However, the instant non-provisional application was filed more than 12 months after the filing dates of provisional applications 60/096,988 and 60/142,200 and thus cannot properly claim the benefit of their earlier filing dates under 35 USC 119(e). Furthermore, 35 USC 111 (b) (7) stipulates "A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title".

This application (09/832,340) is a continuation-in-part of the 09/698,471 application, which was filed October 27, 2000, and the '471 application is a continuation-in-part of the 09/376,837 application, which was filed August 18, 1999. The '837 application was copending

with the 60/096,988, filed on August 18, 1998, and the 60/142,200 application, filed on July 1, 1999.

37 CFR 1.78(a)(2)(i) requires that any non-provisional application claiming the benefit of one or more prior-filed depending non-provisional applications must not only contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed non-provisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---," A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each non-provisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent non-provisional application. See MPEP Section 201.11, Reference to Prior Non-provisional Applications. In the amendment to the specification, filed April 1, 2008, the benefit claim pertaining to the non-provisional applications 09/376,837 and 09/698,471 is initially stated without specifying the relationship of the '837 and '471 applications to the instant application. The inclusion of the relationship in question later on in the amendment is confusing and therefore unacceptable.

A substitute amendment is enclosed in which the applicant has reordered the amendment to the specification as follows:

This application is a continuation-in-part of United States Patent Application 09/698,471, filed October 27, 2000, which claims the benefit of the filing date of United States Provisional Patent Application 60/161,752, filed October 27, 1999, and United States Provisional Patent Application 60/195,491, filed April 10, 2000, and is a continuation-in-part of United States Patent Application 09/376,837, filed August 18, 1999, which claims the benefit of the filing date of United States Provisional Patent Application 60/096,988, filed August 18, 1998, United States Provisional Patent Application 60/142,200, filed July 1, 1999, and United States Provisional Patent Application 60/142,201, filed July 1, 1999. This application claims the benefit of the filing dates of United States Provisional Patent Application 60/195,491, filed April 10, 2000, and United States Provisional Patent Application 60/230,912 filed September 13, 2000., United States Provisional Patent Application 60/142,200, filed July 1, 1999, United States

Patent Application 09/376,837, filed August 18, 1999, and United States Patent Application 09/698,471, filed October 27, 2000, Applications 09/698,471, 60/195,491, 09/376,837, 60/096,988, 60/142,200 and 60/142,201 are all incorporated here by reference. This application is a continuation-in-part of United States Patent Application 09/698,471, filed October 27, 2000, which is a continuation-in-part of United States Patent Application 09/376,837, filed August 18, 1999.

Additionally, the amendment is not acceptable as drafted since it also improperly incorporates by reference the prior-filed application(s). An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. §§ 119(e) after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. §§ 119(e) is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See *Dart Industries v. Banner*, 636 F.2d 684,207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(p).

The substitution amendment incorporates by reference applications 09/698,471 and 60/195,491 (which are incorporated by reference in the first paragraph of the originally-filed specification), application 09/376,837 (which is incorporated by reference in the first paragraph of the 09/698,471 application), and applications 60/096,988, 60/142,200, and 60/142,201, which are incorporated by reference on page 7 of the originally-filed specification, as follows:

The pen could be of the kind that can be tracked by nearby tracking devices such as the pens described in United States Patent Application Serial Numbers 60/096,988, filed August 18, 1998; 60/142,200, filed July 1, 1999; and 60/142,201, filed July 1, 1999, and 09/698,471, filed October 27, 2000, all incorporated by reference.

Also, 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) require a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR §§ 1.78(a)(3) and 1.78(a)(6). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

This is a correct reading.

Applicant : Ilya Schiller et al.
Serial No. : 09/832,340
Filed : April 10, 2001
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Attorney's Docket No.: 19965-0004001

No fees are believed to be due, as the surcharge under 37 CFR 1.17(t) has been paid previously. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

12/12/8



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